

52



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,413	09/20/2000	Koichi Sato	P19601	8542
7055	7590	05/26/2004		
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER SELBY, GEVELL V	
			ART UNIT 2615	PAPER NUMBER

DATE MAILED: 05/26/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/665,413

Applicant(s)

SATO, KOICHI

Examiner

Gevell Selby

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

02

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All / b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Moronaga et al., US 5,956,084.**

In regard to claim 12, Moronaga et al., US 5,956,084, discloses a photographing operation control device for an electronic still camera (see figure 10), comprising:

a buffer memory (see figure 10, element 207) in which an image data obtained through a photographing optical system is temporarily stored; and

a blank photographing operation performing processor (see figure 10, element 210) that performs a photographing operation in a blank photographing mode, such that upon photographing (see figure 11, element 254), said image data is stored in said buffer memory without being stored in an installed recording

Art Unit: 2615

medium(see column 24, lines 30-40), when it is determined that the installed recording medium, having blank recording area, lacks sufficient space for the image data (see column 24, lines 52-58).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084.**

In regard to claim 1, Taniguchi et al., US 6,549,232, discloses a photographing operation control device for an electronic still camera (see figure 2), comprising:

a buffer memory (see figure 2, element 40 and column 8, lines 8-12) in which an image data obtained through a photographing optical system is temporarily stored; and

a blank photographing operation performing processor (see figure 2, element 300) that performs a photographing operation in a blank photographing mode, such that upon photographing, said image data is stored in said buffer memory without being stored in a recording medium, when no recording medium is installed in the electronic still camera (see column 16, lines 11+),

when a recording medium without a blank recording are sufficient to store said image data is installed in the electronic still camera (see column 12, line 64 to column 13, line 6). Taniguchi does not disclose the image is not stored in a recording medium when a recording medium, having a blank recording are sufficient to store said image data is installed in the electronic still camera.

Moronaga et al., US 5,956,084, discloses a digital camera with a photographing mode wherein irrespective of whether the number of remaining frames in the external memory is zero or some other number, depression of the shutter release button is allowed unconditionally and the image is stored in the frame memory (see column 24, lines 30-40).

It would have been obvious to one of ordinary skill in the art to have been motivated to modify Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, to have a blank photographing mode store the image in frame memory when whether the memory is full or not in order to ~~allow~~ allow image capture as taught by Moronaga.

In regard to claim 2, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 1, further comprising a photographing mode selecting processor (see Taniguchi: CPU 30) that sets said blank photographing mode (see Taniguchi: column 17, lines 1-3).

In regard to claim 3, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 2. Taniguchi does not disclose wherein that the said photographing mode selecting

Art Unit: 2615

processor (see Taniguchi: CPU 30) comprises a photographing mode set switch by which said blank photographing mode or internal recording mode is set, and which is provided in a camera body of the electronic still camera. However, it would have been an obvious design decision for one skilled in the art to modify the Taniguchi reference to have a photographing mode selection switch in order to allow the user to select the photographing mode.

In regard to claim 4, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 1, further comprising the recording medium sensing processor (see Taniguchi: switch 10-off) that senses whether a recording medium is mounted, said blank photographing operation performing processor performing a photographing operation in said blank photographing mode when said recording medium sensing processor senses that said recording medium is not mounted (see Taniguchi: column 8, lines 21-23 and column 12, line 11+).

In regard to claim 5, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 1, further comprising a blank recording area sensing processor (CPU 30) that senses whether a blank recording area exists in the recording medium, said blank photographing operation performing processor (CPU 30) performing said photographing operation in said blank photographing mode when said blank recording area sensing processor senses that said recording medium has no blank recording area (see Taniguchi: column 12, line 58 to column 13, line 5).

In regard to claim 6, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 1, further comprising a recording medium sensing processor that senses whether the recording medium is mounted (see Taniguchi: switch 10-On and column 8, lines 21-23), a blank recording area sensing processor (CPU 30) that senses whether a blank recording area exists in the recording medium (see Taniguchi: see column 12, line 58 to column 13, line 5), a normal photographing operation performing processor (CPU 30) that performs a photographing operation in a normal photographing mode (see Taniguchi: figures 18 A and B) in which, after storing said image data in said buffer memory (see Taniguchi: column 26, line 65 to column 27, line 1), said image data is read from said buffer memory and recorded in said recording medium (see Taniguchi column 27, lines 1-19), and a photographing mode selecting processor that selects one of said blank photographing mode (image stored in internal memory) and said normal photographing mode (image stored on memory card), said photographing mode selecting processor being able to select said blank photographing mode when said recording medium sensing processor and said blank recording area sensing processor sense that the recording medium having the blank recording area is installed in said device(see Moronaga: column 12, lines 33-60).

In regard to claim 7, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 1, further comprising an image data transfer processor (CPU 30) that transfers said image

data stored in said buffer to the recording medium (see Taniguchi: figure 18 a and b and column 24, lines 30-40).

In regard to claim 8, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 7, further comprising a normal photographing operation performing processor (CPU 30) that performs a photographing operation in a normal photographing mode (see Taniguchi: figures 18 A and B) in which, after storing said image data in said buffer memory (see Taniguchi: column 26, line 65 to column 27, line 1), said image data is read from said buffer memory and recorded in said recording medium (see Taniguchi column 27, lines 1-19) when said normal photographing mode is set.

In regard to claim 9, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 1, further comprising a mode informing processor (CPU 30) that informs that said blank photographing mode is set (see Taniguchi: column 16, line 60 to column 17, line 3).

In regard to claim 10, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 1, further comprising the recording medium sensing processor (switch 10) that senses whether a recording medium is mounted and a non-mounting condition informing processor that informs that the recording medium is not mounted (see Taniguchi: column 8, lines 21-23).

In regard to claim 11, Taniguchi et al, US 6,549,232 in view of Moronaga et al., US 5,956,084, as described in regard to claim 1, discloses a device according to claim 1,



Art Unit: 2615

further comprising a blank recording area sensing processor (CPU 30) that senses whether a blank recording area exists in the recording medium and a non-existing condition informing processor (CPU 30) that informs that the recording medium has no blank recording area (see Taniguchi: column 16, line 60 to column 17, line 3).

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gevell Selby whose telephone number is 703-305-8623. The examiner can normally be reached on 8:00 A.M. - 5:30 PM (every other Friday off).

Art Unit: 2615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Ngoc-Yen Vu can be reached on 703-305-4946. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gvs



NGOC-YENVU  
PRIMARY EXAMINER